

REMARKS

Claims 1-3 and 11-27 are pending in this application.

Applicants have amended claims 1, 17, and 24. The changes to these claims made herein do not introduce any new matter.

Claim Amendments

Applicants have amended independent claims 1, 17, and 24 to clarify that the contents of the predefined library have been determined independently from the compiler-generated program code that is to be optimized. This feature was originally expressed by the wording “predefined library” since a predefined library is a library the contents of which have been determined in advance of the current optimization run, i.e., independently from the compiler-generated program code that is to be optimized.

This understanding is supported, for example, in Paragraph [0024] of the published application (US 2005/0235268 A1) (Paragraph [0027] of the as-filed specification), which indicates that the predefined library 28 is already present at the beginning of the optimization run, i.e., the contents of the library have been determined independently from the compiler-generated program code that is to be optimized. Furthermore, Paragraph [0027] of the published application (Paragraph [0030] of the as-filed specification) sets forth that the predefined library 28 is present in the second memory area 26 since the time at which the chip for the data carrier 10 was produced, while the optimized program code 44 is only loaded into the first memory area 24 upon completion or initialization or personalization of the data carrier 10, i.e., at a much later time.

Rejection Under 35 U.S.C. § 102

Applicants respectfully request reconsideration of the rejection of claims 1-3, 11-17, and 19-27 under 35 U.S.C. § 102(e) as being anticipated by *Siska* (US 6,263,429 B1). As will

be explained in more detail below, the *Siska* reference does not disclose each and every feature of the subject matter defined in independent claims 1, 17, and 24, as amended herein.

The *Siska* reference discloses a method of compressing programs, especially programs that are used in embedded systems. A program is examined for sequences of lines of code that are identical or substantially similar. When such a sequence is identified, one uncompressed version of the sequence is stored as a microroutine in a microroutine area, and each occurrence of the sequence in the program is replaced by a microcall to the newly added microroutine.

Siska clearly determines both the microroutines and the calls that replace the microroutines in one and the same optimization run for the program that is to be optimized. This is apparent, for example, from Figure 3A of *Siska*, where the occurrences of a code sequence are identified in steps 300, 302, and the code sequence is stored as a microroutine in the microroutine area in step 305, and where the occurrences of the sequence are replaced by microcalls in step 306.

In other words, the contents of the microroutine collection of *Siska* are determined depending on the actual program that is to be compressed. This is in stark contrast to the presently claimed subject matter, which specifies that the contents of the predefined library have been determined independently from the compiler-generated program code that is to be optimized. *Siska* does not disclose (or suggest) this distinctive feature of the presently claimed subject matter.

In the “Response to Arguments” section (see pages 9-10 of the Final Office Action), the Examiner asserts that the code and library of *Siska* are independent of each other because they are stored in two different memory areas. Applicants respectfully submit that this understanding is contrary to the plain meaning of even the previous language used in the claims. In any case, the Examiner’s characterization of the *Siska* reference relative to the

claimed subject matter is no longer applicable in light of the clarifying amendments to the independent claims made herein.

Accordingly, in view of the foregoing, independent claims 1, 17, and 24, as amended herein, are patentable under 35 U.S.C. § 102(e) over *Siska*. Claims 2, 3, and 11-16, each of which depends from claim 1, claims 19-23, each of which depends from claim 17, and claims 25-27, each of which depends from claim 24, are likewise patentable under 35 U.S.C. § 102(b) over *Siska* for at least the same reasons set forth above with regard to the applicable independent claim.

Rejection Under 35 U.S.C. § 103

Applicants respectfully request reconsideration of the rejection of claim 18 under 35 U.S.C. § 103(a) as being unpatentable over *Siska* in view of *Wilkinson et al.* (“*Wilkinson*”) (US 2008/0115117 A1). Claim 18 depends from claim 17. The deficiencies of the *Siska* reference relative to the subject matter defined in present claim 17 are discussed above in connection with the anticipation rejection. The *Wilkinson* reference does not cure the above-discussed deficiencies of the *Siska* reference relative to the subject matter defined in present claim 17. Accordingly, claim 18 is patentable under 35 U.S.C. § 103(a) over the combination of *Siska* in view of *Wilkinson* for at least the reason that this claim depends from claim 17.

Furthermore, with regard to any alleged obviousness of the presently claimed subject matter, as set forth in Applicants’ specification (see Paragraph [0007] of the published application or Paragraph [0010] of the as-filed specification), it is a surprising result that a marked reduction of the size of the program code that is provided for storage in the first memory area can be achieved with the *predefined* library of the presently claimed subject matter, even if *the contents of the predefined library have been determined independently from the compiler-generated program code that is to be optimized*. Before the development of the presently claimed subject matter, one having ordinary skill in the art would not have

thought that any meaningful code size savings were possible with a predefined library of a realistic size. Thus, the result obtained by the presently claimed subject matter demonstrates that the expectation of those having ordinary skill in the art was not correct.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of claims 1-3 and 11-27, as amended herein, and submit that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at **(408) 749-6902**. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. WACHP002).

Respectfully submitted,
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